

**I. Response to Double Patenting Rejections**

**A.** Claims 1 and 6 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1, 13, 14 and 28 of copending Application No. 10/525,386 (US 2006/0055750).

A Terminal Disclaimer is submitted herewith with respect to the rejection based on copending App. No. 10/525,386 (US 2006/0055750), thereby obviating the rejection.

Accordingly, Applicants respectfully request withdrawal of the rejection.

**B.** Claims 1-6 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-5 of copending Application No. 10/714,845 (US 2004/0155947) in view of Provost et al (U.S. Patent No. 6,336,721).

Applicants respectfully traverse the rejection. The Examiner recognizes that the specified claims in copending App. No. 10/714,845 do not teach or suggest all elements of the present claims. Specifically, the specified claims of the '845 application do not teach or suggest the at least one water-miscible organic solvent which satisfies one of the requirements 1) and 2) recited in the present claims.

Provost et al does not remedy this deficiency.

The water-miscible solvent of the present invention is characterized by one of the following features:

- (i) The at least one water-miscible organic solvent consists only of water-miscible organic solvent(s) which hardly dissolves the specific dye (less than 10 (g/100g) at 25 °C).
- (ii) If the at least one water-miscible organic solvent comprises water-miscible organic solvent which easily dissolves the specific dye (10 g/100 g) at 25 °C or more), the contained amount of the water-miscible organic solvent is 10 mass % or less of the ink.

Provost et al does not disclose or suggest the above concept. At best, Provost et al suggest the selection and use amount of a solvent for the purpose of solving a dye, but does not suggest the usage of a solvent which hardly dissolves a dye. Therefore, one of ordinary skill in the art would not have been motivated to modify or combine the subject matter of the specified claims of the '845 application based on the disclosure of Provost et al. Even if modified or combined, the present invention would not have been achieved.

Accordingly, the present invention is not rendered obvious and withdrawal of the rejection is respectfully requested.

**C.** Claims 1-3 and 5-6 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-4 of co-pending Application No. 10/671,529 (2004/0066438) in view of Provost et al.

Applicants respectfully traverse the rejection. The Examiner recognizes that the specified claims in co-pending App. No. 10/671,529 do not teach or suggest all elements of the present claims. Specifically, the specified claims of the '529 application do not teach or suggest

the at least one water-miscible organic solvent which satisfies one of the requirements 1) and 2) recited in the present claims.

Provost et al does not remedy this deficiency for the reasons set forth above.

Accordingly, the present invention is not rendered obvious and withdrawal of the rejection is respectfully requested.

**D.** Claims 1-3 and 5-6 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-4 of Taguchi et al (U.S. Patent No. 7,022,170) in view of Provost.

Applicants respectfully traverse the rejection. The Examiner recognizes that the specified claims in Taguchi et al do not teach or suggest all elements of the present claims. Specifically, the specified claims of Taguchi et al do not teach or suggest the at least one water-miscible organic solvent which satisfies one of the requirements 1) and 2) recited in the present claims.

Provost et al does not remedy this deficiency for the reasons set forth above.

Accordingly, the present invention is not rendered obvious and withdrawal of the rejection is respectfully requested.

## **II. Response to Claim Rejections Under 35 U.S.C. § 103**

Claims 6-10 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Provost et al in view of Fujiwara (U.S. Publication No. 2001/0029869).

As stated above, the water-miscible solvent of the present invention is characterized by one of the following features:

- (i) The at least one water-miscible organic solvent consists only of water-miscible organic solvent(s) which hardly dissolves the specific dye (less than 10 (g/100g) at 25 °C).
- (ii) If the at least one water-miscible organic solvent comprises water-miscible organic solvent which easily dissolves the specific dye (10 g/100 g) at 25 °C or more), the contained amount of the water-miscible organic solvent is 10 mass % or less of the ink.

Provost et al does not disclose or suggest the above concept for the reasons set forth above. That is, at best, Provost et al suggest the selection and use amount of a solvent for the purpose of solving a dye, but does not suggest the usage of a solvent which hardly dissolves a dye.

Fujiwara et al does not remedy this deficiency of Provost et al and therefore, even if combined the present invention would not have been achieved.

Accordingly, the present invention is not rendered obvious and withdrawal of the rejection is respectfully requested.

### **III. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solidited. If any points remain in issue which the

Response under 37 C.F.R. § 1.111  
U.S. App. Ser. No. 10/771,464

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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

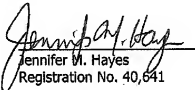
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**23373**

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